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IN THE

Supreme Court of the United States

OCTOBER TERM, 1966

No. 743

NORTON COMPANY, STUDEBAKER-PACKARD CORPORATION, and HADCO CORPORATION, *Petitioners*

v.

MINNESOTA MINING AND MANUFACTURING COMPANY, *Respondent.*

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT AND APPENDIX

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INDEX

	Page
I. Opinions Below	2
II. Jurisdiction	2
III. Reasons Relied Upon For Granting The Writ	3
IV. Questions Presented	4
V. Federal Statutes Involved:	
35 U.S.C. 185	4
35 U.S.C. 184	5
35 U.S.C. 181	5
35 U.S.C. 186	6
VI. Statement Of The Case	7
VII. Argument	8
General	8
Point 1—The Public Interest In National Security Is Adversely Affected	9
Point 2—The Court Below Would Permit Invalid Patents To Operate As Valid Ones	11
Point 3—Section 185 Does Not Provide For Validation Of Patents By Retroactive License	14
Point 4—If The Congress Had Intended That Invalid Patents Could Be Validated, It Would Have Protected Those Persons Already Dealing With The Accused Products	15
Point 5—The Congress Has Never Given the Patent Office Jurisdiction to Alter Patents Except Where Such Jurisdiction Is Explicitly Recited	17
Point 6—The Commissioner Of Patents Has Declined To Rule On The Questions Presented	18
Point 7—The Decision Below Demonstrates Misunderstanding Of The Authorities	19
VIII. Conclusion	23

APPENDIX Page

Opinion Of The Court Of Appeals Below 1A
Opinion Of The District Court Below 9A
Related Opinion Of The District Court Below 18A

TABLE OF CASES

Blake et al. v. *The Bassick Co.*, 146 USPQ 157 (N.D. Ill. 1963) 21
Beckman Instruments, Inc. v. *Coleman Instruments, Inc.*, 338 F.2d 573 (C.A. 7, 1964) 21, 22, 23
Precision Instruments Manufacturing Co. v. *Automotive Maintenance Machinery Co.*, 324 U.S. 806, 815 13
Rinker & Duva, In re, 145 USPQ 156 .....15, 18, 20
Sears, Roebuck & Co. v. *Stiffel Co.*, 376 U.S. 225 (1964) 14
Spokane & Inland Railroad v. *United States*, 241 U.S. 344 11

OTHER AUTHORITIES

Title 28 United States Code

Section 1254(1) 2
Section 2101(c) 2
Section 1291 22
Section 1338 2
Section 2201 12

Title 35 United States Code

Section 181 5
Section 184 .....3, 4, 5, 8, 9, 12, 13, 14, 19, 20, 21
Section 185 .....3, 4, 7, 8, 9, 14, 15, 19, 21, 22, 23
Section 186 .....6, 9, 18
Section 251 17
Section 252 .....16, 17
Section 253 17
Section 254 17
Section 255 17
Section 256 18

Rule 22(3) of Supreme Court of the United States ... 2
Congressional Hearings on H.R. 4687 10
Boykin Act (Act of Aug. 8, 1946, 60 Stat. 940), Section 6 20

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT

Petitioners (defendants and appellees below) respectfully pray that a Writ of Certiorari issue to the United States Circuit Court of Appeals for the Sixth Circuit to review a Judgment of that Court entered September 13, 1966 which reversed a Judgment of the United States District Court for the Northern District of Ohio, Eastern Division, entered March 30, 1965, which District Court judgment granted petitioners' Motion for Summary Judgment and dismissed respondent's complaint for patent infringement on the

ground that the patent in suit was invalid as a matter of law pursuant to Title 35 United States Code, Section 185.[1]

I. OPINIONS BELOW

The opinion of the United States Court of Appeals for the Sixth Circuit, — F.2d —; 151 USPQ 1, appears in the appendix to this petition, pages 1A to 9A. The opinion of the United States District Court for the Northern District of Ohio, 240 F. Supp. 150, 145 USPQ 81, appears in the appendix to this petition, pages 9A to 18A. An earlier decision of the same District Court in this case, not appealed from, but related to the one appealed from, appears at 144 USPQ 272 and in the appendix to this petition, pages 18A to 29A.

II. JURISDICTION

This Court has jurisdiction to issue the writ now requested under the provisions of Title 28, United States Code, Sections 1254(1) and 2101(c), and also Rule 22(3) of this Court.

The Judgment of the Court below was entered September 13, 1966.

No Petition for Rehearing has been filed in the Court below and no extension of time for filing this Petition has been requested.

The jurisdiction of the District Court below was founded on the patent laws of the United States, Title 35 United States Code, and Title 28 United States Code, Section 1338. The jurisdiction of the Circuit Court of Appeals below was founded on Title 28 United States Code, Section 1291.

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[1] All references herein to Title 35 United States Code are to the 1952 Edition thereof, with amendments to date, if there be any.

III. REASONS RELIED UPON FOR GRANTING THE WRIT

Important questions of Federal law involving both the national security and commercial rights of the public are presented by this petition, which have not been, but should be settled by this Court.

The Court of Appeals has erroneously created a broad and unintended exception to the general prohibition of a patent statute, Title 35 U. S. Code, Section 185 which was enacted in the interest of national security. The decision of the Court of Appeals so favors the private interests of the patent owner, that it will encourage violations of the statute with impunity, and will thwart the general national security purposes of the statute.

The Court of Appeals has misconstrued Section 185 in such manner that patents which are invalid by its terms may now operate as valid ones, wherefore the public interest is seriously and adversely affected.

Federal Patent Statute, Title 35 United States Code, Section 184 prohibits filing foreign patent applications earlier than six months from the filing date of the U. S. patent application unless a license to do so has first been obtained from the Commissioner of Patents. Section 185 provides, however, that a person "shall not receive a United States Patent" without obtaining such a license and if such a patent does issue that it "shall be invalid". The Court of Appeals has ignored these provisions.

Numerous cases other than the present one have already arisen wherein the application and interpretation of this statute is involved, and the same questions as now presented will continue to arise indefinitely in other cases, unless now settled by this Court.

IV. QUESTIONS PRESENTED

1. When a United States patent is invalid at the time it issues, under Title 35, U.S.C., Section 185, for failure of the patentee to procure the required foreign filing license prescribed in Section 184 of Title 35, can a license thereafter obtained from the Commissioner of Patents cause the invalid patent to become valid?

2. Where a patent on a product is invalid upon issuance, and throughout the period of a defendant's manufacture of the product on which the Complaint was based, because the plaintiff-patent owner filed premature patent applications in foreign countries without securing a license to do so as required by 35 U.S.C. 184,—can the Commissioner of Patents by issuing *ex parte* to the plaintiff a license authorizing such foreign filings retroactively, even while the patent is in litigation before a District Court, take away from the defendant and therefore from the public the right to rely on this defense of invalidity, in respect of manufacture of the product during the period of time after the issuance of the patent and before the retroactive license was obtained?

V. FEDERAL STATUTES INVOLVED

A. The statute directly involved:

Title 35 United States Code, Section 185:

> Notwithstanding any other provisions of law any person, and his successors, assigns, or legal representatives, shall not receive a United States patent for an invention if that person, or his successors, assigns, or legal representatives shall, without procuring the license prescribed in section 184 of this title, have made, or consented to or assisted another's making, application in a foreign country

for a patent or for the registration of a utility model, industrial design, or model in respect of the invention. A United States patent issued to such person, his successors, assigns, or legal representatives shall be invalid.

B. The statute referred to in Section 185:

Title 35 United States Code, Section 184

Except when authorized by a license obtained from the Commissioner a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country. A license shall not be granted with respect to an invention subject to an order issued by the Commissioner pursuant to section 181 of this title without the concurrence of the head of the departments and the chief officers of the agencies who caused the order to be issued. The license may be granted retroactively where an application has been inadvertently filed abroad and the application does not disclose an invention within the scope of section 181 of this title.

The term "application" when used in this chapter includes applications and any modifications, amendments, or supplements thereto, or divisions thereof.

C. The pertinent portion of the statute referred to in Section 184:

Title 35 United States Code, Section 181 (Third and Fourth paragraphs omitted).

Whenever publication or disclosure by the grant of a patent on an invention in which the Govern-

ment has a property interest might, in the opinion of the head of the interested Government agency, be detrimental to the national security, the Commissioner upon being so notified shall order that the invention be kept secret and shall withhold the grant of a patent therefor under the conditions set forth hereinafter.

Whenever the publication or disclosure of an invention by the granting of a patent, in which the Government does not have a property interest, might, in the opinion of the Commissioner, be detrimental to the national security, he shall make the application for patent in which such invention is disclosed available for inspection to the Atomic Energy Commission, the Secretary of Defense, and the chief officer of any other department or agency of the Government designated by the President as a defense agency of the United States.

D. The penalty statute related to Sections 181 and 184:

Title 35 United States Code, Section 186

Whoever, during the period or periods of time an invention has been ordered to be kept secret and the grant of a patent thereon withheld pursuant to section 181 of this title, shall, with knowledge of such order and without due authorization, willfully publish or disclose or authorize or cause to be published or disclosed the invention, or material information with respect thereto, or whoever, in violation of the provisions of section 184 of this title, shall file or cause or authorize to be filed in any foreign country an application for patent or for the registration of a utility model, industrial design, or model in respect of any invention made in the United States shall, upon conviction, be fined not more than $10,000 or imprisoned for not more than two years, or both.

VI. STATEMENT OF THE CASE[2]

Respondent (plaintiff and appellant below) sued the petitioners (defendants and appellees below), charging infringement of respondent's United States patent 2,958,597.[3]

When issued on November 1, 1960 the patent was invalid under Title 35 United States Code, Section 185[4] because an application had been filed in each of five foreign countries[5] prior to six months after the filing of the application in the United States without a license having been procured authorizing the foreign filings.

Petitioners moved the District Court for summary judgment of dismissal of the Complaint due to the invalidity of the patent because of the aforesaid violation of Section 185. On January 4, 1965 the District Court delivered its decision granting the motion and holding the patent invalid.[6] The respondent has not pursued an appeal from the merits of that decision.

Subsequent to the District Court's decision on January 4, 1965, and more than four years after the patent had been issued, respondent obtained from the United

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[2] The transcript of the record accompanying this petition consists of the separate printed appendices of the respective parties filed in the Court below. For convenience hereinafter the reference "RA" is to the respondent's appendix below (appellant, brown cover). Similarly, the reference "PA" hereinafter is to petitioners' appendix below (appellees, blue cover).

[3] The Complaint appears at RA 9a, and the patent at RA 165a.

[4] Hereinafter, "Section 185", if not cited in full.

[5] Respondent filed unlicensed applications in: Argentina (PA 33B), Australia (PA 34b), Italy (PA 35b), Japan (PA 36b), and Sweden (PA 37b).

[6] The January 4, 1965 decision of District Court below appears at pages 18A-29A of the appendix to this petition.

States Patent Office a license authorizing the foreign filings.[7] [8] Respondent secured this license by representations to the Patent Office that the foreign filings had been made inadvertently.

Respondent then moved the District Court to reconsider its January 4, 1965 decision, asserting that the invalid patent had become valid. The District Court overruled that motion March 10, 1965,[9] declaring that any retroactive license under Title 35 United States Code, Section 184[10] was inoperative to create a valid United States patent because it had been procured after the issuance of the patent.

On appeal the United States Circuit Court of Appeals for the Sixth Circuit reversed the March 10, 1965 decision of the District Court, and this petition follows.[11]

VII. ARGUMENT

General

The reason the writ should be allowed is that Federal Patent Statute Title 35 United States Code, Section 185 has been misconstrued by the Court of Appeals, thus leaving important Federal questions unsettled and in a manner which seriously and adversely affects the public interest. The right of the public to be free of

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[7] License at RA 196a.

[8] Another license had been previously granted, but it was not granted until after the foreign filings and did not authorize the foreign filings, see license at RA 142a.

[9] The March 10, 1965 decision is at pages 9A-18A of the appendix to this petition.

[10] Hereinafter, "Section 184", if not cited in full.

[11] The decision of the Court of Appeals appears at pages 1A-9A of the appendix hereto.

unwarranted patent monopolies is involved. Aspects of the procedures for assuring the national security are involved. The decision below enables invalid patents to pose as valid ones. Manifestly, the Congress never intended such results to obtain, and its actions and its statutory language make clear that it did not so intend. If permitted to stand as law, the erroneous interpretation of the statute by the Court below will have an impact reaching far beyond the present litigants and will create unwarranted conditions for other parties in other situations. The questions presented have already arisen in many other cases,[12] and will continue to arise indefinitely unless settled by this Court.

Point 1—The Public Interest in National Security Is Adversely Affected

It is extremely important to the public interest that there be some teeth in Sections 184 and 185. These sections are obviously intended to prevent dissemination of information abroad until officials of the United States have *first* had an opportunity to inspect the application as filed in the United States. Inasmuch as fines up to $10,000.[13] would not be a significant deterrent to wealthy corporations, it is logical that Congress intended to strip same of their United States patent rights if applications were filed abroad in disregard of Section 184.

The effect of the ruling by the Court below is to greatly reduce the hazards of ignoring or being care-

[12] The other decisions are cited in the decision of the Court below, see Page 8A of the appendix to this petition.

[13] Provided for in Title 35 United States Code, Section 186, printed at page 6 this petition.

less about the dissemination of information abroad in filing for foreign patents. Thus, *the Court below encourages exactly what the statute is intended to prevent,* to wit, private persons (patent applicants) rather than Government officials *first* making the decision as to presence of security matter.

More than disclosures of secrets such as inventions in atomic energy are involved. For example, in Hearings on H.R. 4687, Congressman Willis described the purpose of the legislation in the following terms:[14]

> "Mr. Willis: Of course, we all have in mind when we talk about secrecy and national defense, some weapon or some new invention almost along the line of atomic energy, and none of us would oppose that kind of legislation on that question, but we must remember that this bill goes much farther than that. For instance, during the last war, *such things as paint* were held to be necessary for the national defense."

The Court of Appeals has read a retroactive license *exception* into the Statute in such a broad manner as to encourage non-compliance with the general policy of the statute, which is to prohibit the filing of foreign patent applications *without first securing a license to do so.* Under this interpretation, corporations owning U. S. patent applications may file with impunity in foreign countries without waiting to obtain a license to do so, knowing that they can go back to the Commissioner at any time they choose, even years later, and obtain a retroactive license, if the public has not submitted to their invalid patent and if it then becomes necessary to bring suit on it.

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[14] PA 187a.

This interpretation, which unduly broadens the exception to the statute, violates the elementary rule which has been pronounced by this Court, that exceptions from a general policy which a law embodies should be *strictly construed*, and should not be interpreted to impair the general purposes intended to be accomplished by the law. *Spokane & Inland Railroad* v. *United States*, 244 U.S. 344.

Point 2—The Court Below Would Permit Invalid Patents To Operate as Valid Ones

Another area wherein the public interest is seriously and adversely affected by the ruling of the Court below, is in respect of invalid patents being able to pose and operate as valid patents.

The unfortunate interpretation by the Court of Appeals below means that after an invalid patent has issued, and members of the public have engaged in business, and even after suit has been brought on such an invalid patent, and even after a District Court has dismissed the suit because of such invalidity, the invalid patent can then be made valid.

The Court of Appeals below has gone so far as to enable the patentee to recover damages for the period during which the patent was invalid.

Under the ruling of the Court of Appeals below, no member of the public may dare to utilize the subject matter of the *invalid* patent, lest at some later time the patentee may appear with allegations of "inadvertence", obtain a retroactive license, and proceed to enforce the otherwise invalid patent even as to the period it was invalid. The longer the patentee can delay his allegations of "inadvertence" the more difficult it will be for the public to muster rebuttal evidence

on the point. Until a member of the public would take the risk of actually entering business and be then accused of infringement, he could not even bring a declaratory judgment action to test the ability of the patentee to prove "inadvertence".[15] It will be seen that the ability to avoid test of the patent will protect parties who deliberately ignore Section 184, and file within six months in foreign countries without license.

The dangers are quite real. There are several countries which have laws to the effect that a printed publication anywhere in the world describing an alleged invention will bar a valid patent in that country unless an application is filed therein before the publication date.[16] There are also countries which furthermore have no reciprocal agreement with the United States whereby a filing date in the latter is effective in the other country.[17] Still other countries require that an application be filed within six months of a publication abroad by the applicant.[18] Thus there will be situations where a party in the United States will become aware that a bar is running against him in a foreign country and he will have to obtain a filing date immediately *in that foreign country* to have a valid patent therein. Thus he may deliberately place his own private interests above those of the public and file in that country without obtaining a license under Section 184 because the other country will not excuse or delay the

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[15] The declaratory judgment jurisdictional statute, Title 28 United States Code, Section 2201, requires that there be an "actual controversy".

[16] e.g., Argentina, Sweden and Italy, wherein respondent filed without license.

[17] e.g., Argentina, wherein respondent filed without license.

[18] e.g., Japan, wherein respondent filed without license.

application of its laws while the license is awaited in the United States.

The real effect of the lower Court's ruling, therefore, is to enable a person who has deliberately violated Section 184 to nevertheless intimidate the public and prospective manufacturers by causing them as a practical matter to submit to his invalid patent as if it were valid. This he can do, as was done in the present case, by not informing the United States Patent Office of the foreign filings. Such a result is entirely contrary to the public interest, which is paramount to that of the patentee. As this Court held in *Precision Instrument Manufacturing Co.* v. *Automotive Maintenance Machinery Co.*, 324 U.S. 806, 815:

> "The possession and assertion of patent rights are 'issues of great moment to the public.' Hazel-Atlas Glass Co. v. Hartford-Empire Co., 322 U.S. 238, 246, 88 L. ed. 1250, 1255, 64 S. Ct. 997. See also Mercoid Corp. v. Mid-Continent Invest. Co., 320 U.S. 661, 665, 88 L. ed. 376, 380, 64 S. Ct. 268; Morton Salt Co. v. G. S. Suppiger Co., (U.S.) supra; United States v. Masonite Corp., 316 U.S. 265, 278, 86 L. ed. 1461, 1475, 62 S. Ct. 1070. A patent by its very nature is affected with a public interest. As recognized by the Constitution, it is a special privilege designed to serve the public purpose of promoting the 'Progress of Science and useful Arts.' At the same time, a patent is an exception to the general rule against monopolies and to the right to access to a free and open market. The far-reaching social and economic consequences of a patent, therefore, give the public a paramount interest in seeing that patent monopolies spring from backgrounds free from fraud or other inequitable conduct and that such monopolies are kept within their legitimate scope."

The patent laws must be definite. The Constitutional purpose of the patent laws to promote the useful arts is not carried out by keeping the public uncertain as to what it can do and what it cannot do because of a patent. As this Court has recently stated in *Sears, Roebuck & Co.* v. *Stiffel Co.*, 376 U.S. 225, 229 (1964):

> "The grant of a patent is the grant of a statutory monopoly . . . Patents are not given as favors, as was the case of monopolies given by the Tudor monarchs . . . But in rewarding useful invention, the 'rights and welfare of the community must be fairly dealt with and effectually guarded.' Kendall v. Windsor, 21 How 322, 329, 16 L. ed. 165, 168 (1859). *To that end the prerequisites to obtaining a patent are strictly observed, and when the patent has issued the limitations on its exercise are equally strictly enforced.*" (emphasis added)

Point 3—Section 185 Does Not Provide for Validation of Patents by Retroactive License

By its plain language, Section 185 declares any issued United States patent to be invalid, if an application for the invention had been filed in a foreign country prior to six months after the application had been filed in the United States and no license had been granted prior to and authorizing the foreign filings. As admitted by respondent, the patent in suit was invalid when issued because no license authorizing the foreign filings had been procured until *after* the issuance of the patent.

Respondent contended and the Court of Appeals below held that a license procured after the foreign filing would save its patent, because Section 185 refers to Section 184, and the latter provides that a license may be granted retroactively if the foreign filing was inadvertent.

The Court of Appeals below is in error. Section 185 explicitly provides that *"Notwithstanding any other provisions of law"* the license must be procured before the foreign filing.[19] Note particularly the language, "—a person—shall not receive a United States patent—if that person—*shall, without procuring the license,*—have made [the foreign filing]—." Note also the closing sentence of Section 185, "A United States patent issued to such person—*shall be invalid.*"

The foregoing recitals clearly preclude a "retroactive" license procured after the United States patent is issued from being effective under Section 185 to validate that patent. This is because Section 185 plainly provides that if a license has not been procured a party, "—*shall not receive* a United States patent—", and any such, "—*shall be invalid.*"

The Commissioner of Patents in *In re Rinker & Duva,* 145 USPQ 156 (Dec. 30, 1964) himself expressed the view that Section 185 does not involve retroactive licenses:

> "Section 185 is not concerned with retroactive licenses—."

Point 4—If the Congress Had Intended That Invalid Patents Could Be Validated, It Would Have Protected Those Persons Already Dealing with the Accused Products

If the Congress had intended that an invalid patent could suddenly spring to life, i.e., become enlarged in scope, it certainly would have provided protective measures for those members of the public already engaged in manufacturing products that the "patentee"

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[19] Throughout this petition all emphasis in quotations is added unless otherwise indicated.

would accuse. For example, the statutes providing for enlarged reissue patents protect those already in business, see Title 35 United States Code, Section 252, second paragraph:

> "No reissued patent shall abridge or affect the right of any person or his successors in business who made, purchased or used prior to the grant of a reissue anything patented by the reissued patent, to continue the use of, or to sell to others to be used or sold, the specific thing so made, purchased or used, unless the making, using or selling of such thing infringes a valid claim of the reissued patent which was in the original patent. The court before which such matter is in question may provide for the continued manufacture, use or sale of the thing made, purchased or used as specified, or for the manufacture, use or sale of which substantial preparation was made before the grant of the reissue, and it may also provide for the continued practice of any process patented by the reissue, practiced, or for the practice of which substantial preparation was made, prior to the grant of the reissue, to the extent and under such terms as the court deems equitable for the protection of investments made or business commenced before the grant of the reissue."

The absence of such protective measures in the statutes under consideration indicates that Congress did not intend to create a situation where the rights of the public would need to be protected against invalid patents which were made valid after they had issued.

Point 5—The Congress Has Never Given the Patent Office Jurisdiction to Alter Patents Except Where Such Jurisdiction Is Explicitly Recited

As the District Court below noted (Appendix page 10A, 11A), the Congress has never conferred jurisdiction upon the Patent Office to alter patents *after* they are issued, except in cases where the Congress has explicitly referred to *patents* and has *clearly* expressed its intention that jurisdiction over issued patents was being taken from the Courts and given to the Patent Office. In the "reissue" statute, Title 35 United States Code, Section 251, the language is:

> "Whenever any *patent* is, through error—invalid—."

Similarly in Title 35 United States Code, Section 252 which deals with the effect of a reissued patent, the statute reads at the outset:

> "The surrender of the original *patent* shall take effect—."

Again, the Disclaimer statute, Title 35 United States Code, Section 253 provides:

> "Whenever, without any deceptive intention, a claim of a *patent* is invalid—."

Still further, in each of the "Certificate of Correction" patent statutes, the word "patent" appears. Thus, Title 35 United States Code, Section 254 provides:

> "Whenever a mistake in a *patent*—."

And Title 35 United States Code, Section 255 provides:

> "Whenever a mistake—appears in a *patent*—."

In the "Misjoinder of Inventor" provisions of Title 35 United States Code, Section 256, the statutes provides:

> "Whenever a *patent* is issued on the application of persons as joint inventors—."

The history of patent legislation thus consistently shows that when the Congress has intended to authorize the Commissioner of Patents to alter *patents,* it has used the word "patent" and has left no doubt about the matter. Oviously, if the Congress had meant that the Commissioner of Patents could affect or alter the condition of an already granted patent invalid under Section 185, it would have explicitly used the word "patent" in connection with the ability of the Commissioner of Patents to grant a license retroactively.

Point 6—The Commissioner of Patents Has Declined To Rule on the Questions Presented

The practice of the Commissioner of Patents in granting retroactive licenses where issued patents are involved has been misconstrued by the Court of Appeals below and other District Courts. The Commissioner has *not* ruled that issued patents are saved. Instead, his position is that he does not know the effect of retroactive licenses on issued patents, and he has left it to the Courts to decide, see *In re Rinker & Duva,* 145 USPQ 156, where he stated:

> "Whether or not the granting of such a license could serve to validate a patent which had been issued before the license was granted is, of course, *a matter for determination by the courts."*

It should be noted in passing that there are other reasons for granting retroactive licenses, e.g., the effect thereof in respect of persons otherwise subject to felony conviction under Section 186 of Title 35.

Point 7—The Decision Below Demonstrates Misunderstanding of the Authorities

Petitioner believes the primary purpose of this petition is to explain to this Court why the writ should be granted, and an exhaustive analysis of the merits of the case more properly awaits the briefs subsequent to the hoped-for grant of this petition. However, some further comment on the merits herein may be helpful to show that it is the decision of the District Court below which is correct, rather than that of the Court of Appeals, wherefore this Court should grant this petition and review the case because of the serious involvement of the public interest in the premises.

The District Court carefully reviewed the history of the statutes and found that the mandatory language of Section 185 was clear and its meaning unmistakable, fulfilling the aim of Congress as expressed in the connected Committee Reports to permit the Government, not the individual, to determine whether the national interest might be impaired by the filing in a foreign country of an application for patent. Having reviewed the legislative history, the District Court concluded that the Congress did not intend the Patent Office to grant a retroactive license to cure patents which were invalid upon issuance because of violations of Section 184. The District Court went on to say that whatever doubt there may be on the issue is resolved by the resounding language of Section 185, the sanctioning provision, emphasizing that Section 185 provides that notwithstanding any other provisions of law a person shall not receive a United States patent if he has not procured the license prescribed in Section 184, and any patent so issued shall be invalid.

When compared to the District Court's decision, the decision of the Court of Appeals is not convincing.

Whereas the District Court carefully considered the legislative history and obviously understood it, the Court below simply noted the differing contentions between appellant and appellee and said that "We do not consider resolution of this contest necessary here—."[20]

The Court of Appeals below refused to recognize the significance of the Boykin Act being omitted from the present statutes now under consideration.[21] However, the District Court below realized that the Boykin Act provision had been purposely omitted from the new act.

The Court below is flatly in error in its opinion in stating that, "The Commissioner of Patents has, by granting retroactive licenses after a patent has issued, expressed an administrative interpretation contrary to the decision we review.[22] In point of fact, the Commissioner of Patents in *In Re Rinker & Duva,* 145 USPQ 156 (1964) expressly stated that while he was issuing licenses, he was not deciding the *effect* thereof on already granted patents but was leaving that to the Courts (see quote, p. 18).

The District Court also found Congressional intent to limit the granting of a retroactive license that would satisfy Section 184 to be in the period prior to the issuance of the patent, by emphasizing that had Congress intended otherwise the second use of the word "application" in the last sentence of the first paragraph of Section 184 would have been followed by the

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[20] See page 7A, appendix hereto.

[21] See page 7A, appendix hereto.

[22] At page 8A, appendix hereto.

words "or patent".[23] This was a highly logical and pertinent observation of the District Judge in arriving at the correct interpretation of Sections 184 and 185. However the Court below in its decision indicated its inability to understand this point:

> "We are not sure we can understand this contention.[24]

In its opinion the Court below cites the decisions of various other District Courts upon the subject at hand.[25] The decisions of the other District Courts lack any serious contemplation of the *adverse effect upon the public interest* under a ruling such as by the Court of Appeals below. At best, some of the Courts mention security, but none grasp the potential situations that could develop if the foreign filing practice became what the Court of Appeals below would now permit. None of the other District Courts discuss the *evil of permitting invalid patents to pose as valid ones.*[26]

In summary as to the other cases, while there are many, they do not represent the careful thought given to the issue by the District Court below, and the entire subject needs the review of this Court.

The District Court, relying on *Beckman Instruments, Inc. et al.* v. *Coleman Instruments, Inc.*, 338 F. 2d 573, C.A. 7, 1964, held the Hoover patent in suit to be invalid from the date of its issuance, under 35 United

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[23] At page 16A, appendix hereto.

[24] At page 7A, appendix hereto.

[25] At page 8A, appendix hereto.

[26] One case includes a fleeting mention of public uncertainty as to validity or invalidity, but no elaboration upon the point, see *Blake* v. *Bassick Co.*, 146 USPQ 157, 160 (N.D. Ill. 1963).

States Code 185. The Court of Appeals has nullified the protection which is afforded to the public by the Beckman case, and has virtually read Section 185 out of the statute, in ruling that the petitioner cannot raise this defense of invalidity in respect to its manufacture of the accused products, even for the period after issuance of the patent and before the obtaining of the retroactive license. The Court of Appeals ruled against petitioner without more discussion than as follows (Appendix 8A):

> "Norton suggests that a retroactive curing of the defect here involved would leave unanswered the question whether there could have been any actionable infringement between the issuance of the patent and the grant of the retroactive license. *Lest this point be further litigated upon remand,* we hold that the defect of premature filing *has been cured* as of the date provided in the retroactive license, viz., January 8, 1959."

Under the *Beckman* case, the defendant, like any other member of the public, had the right to manufacture the accused product without liability for infringement of the Hoover patent, because that patent was invalid from the date of its issuance under 35 United States Code 185. The *Beckman* Court (C.A. 7) said:

> "* * * It is our conclusion and we so hold that the patent was issued on contravention of the statute and is, therefore, invalid (page 577 of 338 Fed. 2d)."

The petitioner, like any other member of the public, should not be required to submit to an invalid patent. And the right to defend against such a patent because of its invalidity from the time of its issuance, should not be taken away from the public.

The decision of the Court of Appeals below is so extreme in permitting recovery during the period of invalidity that even after the conclusion of a litigation (e.g., *Beckman, supra*) the "patentee" of the invalid patent could by a retroactive license again litigate against the same defendant. Surely the Congress never intended such a grotesque result to obtain.

VIII. CONCLUSION

It is submitted that this Court should settle the meaning and effect of Section 185 so that the National Security will be better insured and the public protected from the oppression of invalid patents posing as valid ones.

Respectfully submitted,

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